REMARKS

Claims 26-46 are pending in this application and were previously added. Claims 1-25 were previously canceled. New claim 47 has been added.

Claims 26, 32, 38, and 44 are currently amended in order to clarify that the physical key from which the playing device receives a key code is a physical object adapted to be carried by a user apart from the playing device. New claim 47 is directed to the physical key itself and requires that the key be a physical object transportable by a user apart from the playing device. Support for the amendment may be found throughout the specification in general and, for example, in the following excerpts:

- *See* key 114 in FIG. 4

- "...the key provider ships the physical electronic key to the new user via a package courier such as the U.S. Postal Service, United Parcel Service, or Federal Express..." Page 5, lines 29-31

- "...the device contains a wireless transceiver adapted to receive a radio frequency signal transmitted by a corresponding wireless transceiver in the user's physical electronic key..." Page 7, lines 25-27

- "...with the user's physical electronic key within a short range (e.g., few meters of the playing device, the playing device reads (1) the key code carried in a radio frequency signal transmitted by the transceiver in the key..." Page 7, lines 31-33

- "...the device continues to play the digital content only while the key is sufficiently close to the device to communicate the key code to the device...If the key is moved out of range, the device is no longer enabled to decrypt and play the digital content." Page 8, lines 16-21

- "In other alternative embodiments, the communication between the user's physical electronic key and the playing device is not wireless. Rather, in one

alternative embodiment, the user's physical electronic key communicates the key code to the playing device via a transmission line such as a serial cable that plugs into the key at one end and the playing device at the other end. In another alternative embodiment, the key is a smart card or magnetic card into which the key code is encoded, and the key is configured to physically fit into a card reader slot on the playing device." Page 9, lines 12-19

Various claims are also currently amended to clarify that the physical key need not be "electronic" per se.

Minor Informality

The Office Action states that IDS paper number 6 with references dated 12/2000 is missing and that Applicant is urged to provide the IDS so the references can be considered by Examiner. In response, Applicant notes that such IDS was submitted to the PTO twice -- first on 12/27/00 when the application was originally filed and second on 9/11/01 with the Response to Notice to File Missing Parts. The IDS was submitted the second time on 9/11/01 because the original was apparently misplaced. The Examiner did, in fact, consider this IDS. The IDS is one of the three IDS's attached to the Office Action and, in particular, is the one stamped with a date of 9/14/01 and initialed and signed by the Examiner with a date considered of 3/1/04. Therefore, the Examiner has considered all IDS's.

35 U.S.C. §§ 102, 103 Rejections

Claims 26-36, 38-46 were rejected under 35 U.S.C. 102(e) as being anticipated by Wiser et al. ("Wiser"). Claim 37 was rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hasegawa.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Here, each and every element in at least the independent claims is not found, either expressly or inherently described, in Wiser.

Specifically, the Office Action alleges that Wiser discloses Applicant's claimed physical key in the form of a "passport." Wiser's passport, however, cannot be equated to, or interpreted as, Applicant's physical key. Applicant's physical key is a "physical object adapted to be carried by a user apart from the playing device." To emphasize this fundamental distinction from Wiser, Applicant has amended the claims to recite the foregoing language.

In contrast, Wiser's passport is clearly a data file that, once received by a user, is integrated into the user's playing device and cannot be transported by a user as a physical object apart from the playing device:

- "To purchase a media data file, a consumer first registers with the media licensing center to obtain a digital passport. *The passport is a combination of data* that includes personal information uniquely identifying a user, information confidential to that user, and encryption key information used to encrypt media data for that person's use." Col. 4:12-18.

- "*The passport is a data object that provides the security information particular to each user of the system.* Each user is issued a passport by the media licensing center 110 during the registration process. *The passport is stored on the user's computer and used during playback to decrypt the media key for each media data file 200 purchased by the user.* Whereas encrypting the media key of a purchased media data file 200 with the public key of a user's media player 116 binds the media data file 200 to a specific user, the user's passport in turn enables the user to decrypt the file and play it back on her media player 116. Further, the passport includes confidential personal information of the user, and this deters the user from freely copying and distributing her passport to others." Col. 8:43-56.

- "*The media player 116 is also responsible for storing and managing a user's passport 400,* and accessing the passport data to decrypt audio images in real time as the audio image is being played back." Col. 10:13-16.

- "Once the credit card is authorized, *the media licensing center 110 generates 616 a new passport 400 for the user's media player 116.* The media licensing center 110 generates a public/private key pair to be the consumer's public key 404 and private key 412. *The media licensing center 110 formats the passport 400 as an ASCII file,* including:

  (a) a certificate chain, which includes a hierarchy of certificates, serially signed. The certificate chain begins with the certificate of the media licensing center 110 certificate authority and terminates with the consumer certificate 402.

(b) a consumer certificate 402, signed by the media licensing center 110, including the generated public key 404.

(c) the consumer's private key 412, encrypted with a strong, randomly generated registration key 420.

(d) the consumer personal information 414, also encrypted with the registration key.

(e) the registration key 420 in cleartext.

The consumer's private key 412 and personal information 414 is also digitally signed by the media licensing center's private key to prevent tampering.

The passport 400 is then returned 618 to the Web browser 128 over the secure connection, with a predefined MIME type that identifies it to the Web browser 128 as being data for the media player 116. The Web browser 128 passes 620 the passport 400 to the media player 116." Col. 13:36-63.

- "*The passport is then stored 628 to the local file system of the client computer 126.* The passport 400 may be stored in a default location, or a user's specified one. The file format for the passport 400 is operating system independent to provide for portability of the passport 400 between Microsoft Corp.'s Windows operating system and Apple Computer Inc.'s MacOS." Col. 14:13-19.

It would not have been obvious to modify the digital passport of Wiser to be a physical object adapted to be carried by a user apart from the user's media player. As noted above, Wiser strongly relies upon a digital passport in the form of a data object integrated within a media player. In Wiser, a media licensing center contains a Passport Generation Module that receives a consumer certificate, a user's private key, and user personal information from a web browser generation form, generates a registration key, and then packages all of this data as a registration file to be delivered to the media player. Col. 25:24-30. The media player, in turn, contains a Passport Management Module that operates during registration of the media player and during playback of audio data. During registration, the user's web browser receives from the Passport Generation Module of the media licensing center the registration file that contains the data to be used in the digital passport, and stores it locally in the user's computer. The web browser invokes the media player and provides it with the file name and path of this registration file. The Passport Management Module imports from this registration file the passport data and encrypts it with a user specified passphrase. During playback, the Passport Management Module is used to first decrypt the media key stored therein using the user's private key. The

media key is then used by a playback module in the media player to decrypt the audio data in a purchased media data file. Col. 26:11-34.

Wiser repeatedly discusses and relies upon the above-noted method of creating a digital passport from a registration file transmitted to a user's computer over the web and storing the digital passport as a data object in the user's media player. Wiser never contemplates a digital passport in any other form. To modify the digital passport of Wiser to be a physical object adapted to be carried by a user apart from the user's media player would fundamentally change its principal of operation. Accordingly, it would not have been obvious to modify Wiser to include the claimed invention. (If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Accordingly, for at least the reasons stated above, withdrawal of the prior art rejections over Wiser alone or in combination with Hasegawa is respectfully requested.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. A check in the amount of $43 is enclosed to cover the small entity fee for added independent claim 47.

Dated: April 5, 2004   Respectfully submitted,

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